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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Marc Gianotti
Application No.:	10/674729
Filed:	September 30, 2003
For:	Stents with Elevations at Selected Crossing Points
Examiner:	Bruce Snow
Group Art Unit:	3738

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Docket No.: S63.2-13017-US04

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Respectfully Submitted,

VIDAS, ARRETT & STEINKRAUS, P.A.

Date: July 31, 2006

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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BRIEF ON APPEAL

This is a Brief on Appeal for the above-identified application in which claims 31, 32, 40, 41 and 43-46 were finally rejected in a Final Office Action mailed May 08, 2006. Claims 1-30, 47-65 and 69-75 have been cancelled. Claims 31, 32, 40-46, 66-68 and 76 are pending in the application.

A Notice of Appeal was filed in this case on July 17, 2006. The fees required under §1.17(c) for filing this brief were addressed in the Notice of Appeal. The Commissioner is authorized to charge Deposit Account No. 22-0350 for any other fees which may be due with this Appeal.

A copy of the claims on appeal is presented in the **Claims Appendix** below.

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 2

(i) Real Party in Interest

The application is assigned to SciMed Life Systems, Inc., One SciMed Place, Maple Grove, MN 55311-1566, a Minnesota Corporation and a subsidiary of Boston Scientific Corporation, One Boston Scientific Place, Natick, Massachusetts, 01760-1537, a Delaware Corporation.

(ii) Related Appeals and Interferences

At present there are no related appeals or interferences.

(iii) Status of Claims

Claims 1-30, 47-65 and 69-75 have been cancelled. Claims 66-68 and 76 are allowed. Claim 42 is objected to as being dependent upon a rejected base claim. Claims 31, 32, 40, 41 and 43-46 are pending, have been rejected and are the subject of this appeal.

Claims 31, 32, 40, 41 and 43-46 have been finally rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 5,709,713 to Evans. Claims 31, 32, 40, 41 and 43-46 have been finally rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 5,725,547 to Chuter.

(iv) Status of Amendments

Subsequent to the Final Office Action of May 8, 2006, Applicant filed an Amendment After Final and request for reconsideration on June 19, 2006.

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 3

In an Advisory Action of July 5, 2006 it was indicated that the request for reconsideration in the Amendment After Final of June 19, 2006 has been considered but did not place the application in condition for allowance.

(v) Summary of Claimed Subject Matter

A summary of representative claims and a non-limiting listing of locations where support may be found [bracketed citations] is provided as follows: Independent claim 31 recites “a stent insertable into the body passageway, including a flexible self-expanding braided tubular wall comprising at least one first wire helically wound at a substantially constant first pitch and at least one second wire helically wound at a substantially constant second pitch different from the first pitch” [paragraph 0028, Figs. 1, 3-4, 6-7]. The first and second wires cooperate to form multiple crossing points of the at least one first wire and the at least one second wire [paragraph 0029, Fig. 1]. At selected crossing points, each of the first wire and the second wire is shaped to form an elevation extended away from the braided tubular wall in a selected direction radially of the braided tubular wall [paragraph 29, Figs. 1, 2]. The elevations are arranged in at least one elevation pattern on the braided tubular wall [paragraphs 0029, 0030, 0031 and Figs. 1, 3, 6 and 7]. The at least one elevation pattern has a third pitch different from the first pitch and different from the second pitch [paragraph [0015], Figs. 1, 3-4, 6-7].

Dependent claim 32 recites “the third pitch is less than the first pitch, and less than the second pitch” [Figs. 1, 3-4, 6-7]. Dependent claim 40 recites “the elevations extend radially outwardly from the braided tubular wall” [paragraph 0032, Fig. 5]. Dependent claim 41 recites “the elevations have heights in the radial direction from the braided tubular wall of

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 4

approximately one to two times the diameter of the helically wound wires" [paragraph 0029].

Independent claim 43 recites "a body insertable stent, including a flexible self-expanding braided tubular wall comprising at least one first wire helically wound at a substantially constant first pitch and at least one second wire helically wound at a substantially constant second pitch different from the first pitch [paragraph 0028, Figs. 1, 3-4, 6-7]. The first and second wires cooperate to form multiple crossing points of the at least one first wire and the at least one second wire [paragraph 0029, Fig. 1]. At a number of selected crossing points, said number being substantially less than the total number of crossing points, each of the first wire and the second wire is shaped to form respective first and second elevations extended in the same direction radially away from the braided tubular wall [paragraph 0029, Figs. 1 and 2]. Said elevations are arranged in at least one elevation pattern on the braided tubular wall [paragraphs 0029, 0030, 0031 and Figs. 1, 3, 6 and 7].

Dependent claim 44 recites "elevations extend radially outwardly from the braided tubular wall" [paragraphs 0029, 0030, 0031, Fig. 5]. Dependent claim 45 recites "the at least one elevation pattern has a third pitch different from the first pitch and different from the second pitch" [paragraph [0015], Figs. 1, 3-4, 6-7]. Dependent claim 46 recites "the elevations have heights in the radial direction from the braided tubular wall of approximately one to two times the diameter of the helically wound wire" [paragraph 0029].

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 5

(vi) Grounds of Rejection to be Reviewed on Appeal

1. Whether the Examiner erred in rejecting claims 31, 32, 40, 41 and 43-46 under 35 U.S.C. §102(e) as being anticipated by U.S. 5,709,713 to Evans.

2. Whether the Examiner erred in rejecting claims 31, 32, 40, 41 and 43-46 under 35 U.S.C. §102(e) as being anticipated by U.S. 5,725,547 to Chuter.

(vii) Argument

1. **The Examiner erred in rejecting claims 31, 32, 40, 41 and 43-46 under 35 U.S.C. §102(e) as being anticipated by U.S. 5,709,713 to Evans.**

In the Final Office Action, claims 31-32, 40, 41, 43-46 were rejected under 35 USC 102(e) as being anticipated by Evans et. al. (5,709,713). According to MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." Instant independent claims 31 and 43 each recite "a flexible self-expanding braided tubular wall comprising at least one first *wire* ... and at least one second *wire*" (emphasis added). The Office Action stated that "[i]t is unclear why elements 14 [of Evans] are not 'wire'" and asserted that "elements 14 and 16 [of Evans] are wire." Applicant maintains that Evans does not anticipate instant independent claims 31 and 43 because *the flat ribbon of Evans is not a wire*. Therefore, Evans does not expressly or inherently describe each and every element of the instant independent claims.

Application No: 10/674729
Filed: September 30, 2003

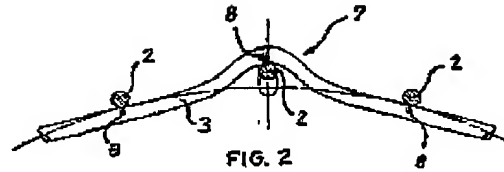
Brief on Appeal
Page 6

Under MPEP 2111 “pending claims must be given their broadest reasonable interpretation consistent with the specification” and that “[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.” MPEP 2111.01 explains further that “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e. as of the effective filing date of the patent application” and that [i]t is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the “ordinary” and “customary” meaning of the terms in the claims.” In addition, the recent case by the Federal Circuit, *Phillips v. AWH Corp.*, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) states that “a person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”

Thus, reference must be made to the written description of the instant application. In the instant application the braided tubular wall 1 is composed of a first plurality of parallel spring stainless steel *wires* 2 and a second plurality of parallel spring stainless steel *wires* 3 (paragraph [0028], emphasis added). According to the specification, “[t]he *diameter* of the *wires* 2 and 3 lie within the range of 0.01 to 0.5 mms” (paragraph [0029], emphasis added)). Thus, a *wire*, as defined in the specification has a cross-sectional diameter such as is shown in Fig. 2 of the instant application which is provided below.

Application No: 10/674729
 Filed: September 30, 2003

Brief on Appeal
 Page 7



In contrast, the specification of Evans defines the interwoven elements forming the braided tubular body as *flat ribbons* having a preferred *width* from 0.12 mm to 1.2 mm and a preferred *thickness* of 0.025 mm to 0.5 mm (col. 6, lines 14-18, emphasis added). An annotated portion of Fig. 1 from Evans is provided below as a visualization of the difference between a wire, shown in Fig. 2 of the instant application provided above, and the flat ribbons that form the braided tubular body of Evans. One of ordinary skill in the art would not consider or confuse the flat ribbon, as explicitly described in Evans, with the wire recited in instant independent claims 31 and 43.

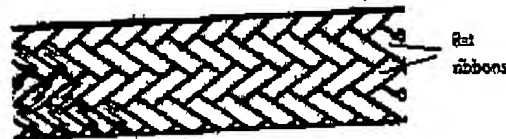


FIG. 1

Because Evans does not teach a wire, which is recited in instant independent claims 31 and 43, Evans does not anticipate instant independent claims 31 and 43. Therefore, instant independent claims 31 and 43 and the claims dependent therefrom are in condition for allowance. Applicants request reversal of the rejection.

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 8

2. The Examiner erred in rejecting claims 31, 32, 40, 41 and 43-46 under 35 U.S.C. §102(e) as being anticipated by U.S. 5,725,547 to Chuter.

In the Office Action, claims 31-32, 40, 41, 43-46 were rejected under 35 USC 102(e) as being anticipated by Chuter (5,725,547). Instant independent claims 31 and 43 recite "at least one first wire helically wound at a substantially constant first pitch and at least one second wire helically wound at a substantially constant second pitch different from the first pitch." The Office Action states that the windings on the stent in Chuter do not have a constant pitch yet the windings are substantially constant because "substantially" is undefined in applicant's specification.

The Federal Circuit, in *Deering Precision Instruments L.L.C. v. Vector Distribution Systems Inc.*, 68 USPQ2d 1716, 1721 (CA FC 2003), noted that there are several dictionary meanings of substantially and that "our cases recognize the dual ordinary meaning of this term as connoting a term of approximation or a term of magnitude [citing *Epcon*, 279 F.3d at 1031 ("The phrase 'substantially constant' denotes language of approximation, while the phrase 'substantially below' signifies language of magnitude, i.e., not insubstantial.")]." The Federal Circuit then stated that "[s]ince the term 'substantially' is capable of multiple interpretations, we turn to the intrinsic evidence [the specification] to determine which interpretation should be adopted."

Applicant asserts that when the specification, which includes the drawings, of the instant application is reviewed, it is clear that "substantially" in the instant application is used as a term of approximation. Applicant asserts that Figs. 1, 3, 4, 6 and 7 of the instant application illustrate "at least one first wire helically wound at a substantially constant first pitch and at least

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 9

one second wire helically wound at a substantially constant second pitch different from the first pitch” as recited in independent claims 31 and 43. For reference, Fig. 1 of the instant application is provided below.

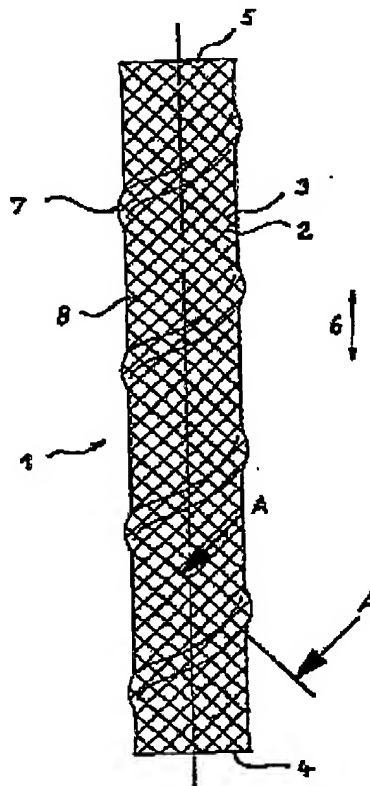


FIG. 1

Since the Office Action admits that “the first and second windings [of Chuter] do not have a constant pitch over the entire length of the stent,” and the meaning of “substantially” in the instant application is a term of approximation, Chuter does not teach a substantially constant first pitch and a substantially constant second pitch. Therefore, Chuter does not anticipate instant independent claims 31 and 43 and Applicant requests reversal of the rejection.

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 10

CONCLUSION

Instant claims 31-32, 40, 41, 43-46 are patentably distinct over Evans and over Chuter. Consequently reversal of the rejections is respectfully requested.

Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS, P.A.

Date: July 31, 2006

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Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 11

(viii) Claims Appendix

1-30. (Cancelled)

31. (Previously Presented) A stent insertable into the body passageway, including:
a flexible self-expanding braided tubular wall comprising at least one first wire helically wound at a substantially constant first pitch and at least one second wire helically wound at a substantially constant second pitch different from the first pitch whereby the first and second wires cooperate to form multiple crossing points of the at least one first wire and the at least one second wire;

wherein at selected crossing points, each of the first wire and the second wire is shaped to form an elevation extended away from the braided tubular wall in a selected direction radially of the braided tubular wall; and

wherein said elevations are arranged in at least one elevation pattern on the braided tubular wall, and the at least one elevation pattern has a third pitch different from the first pitch and different from the second pitch.

32. (Previously Presented) the stent of claim 31 wherein:
the third pitch is less than the first pitch, and less than the second pitch.

33-39. (Cancelled)

40. (Previously Presented) the stent of claim 31 wherein:
said elevations extend radially outwardly from the braided tubular wall.

41. (Previously Presented) The stent of claim 31 wherein:
the elevations have heights in the radial direction from the braided tubular wall of approximately one to two times the diameter of the helically wound wires.

42. (Previously Presented) The stent of claim 31 wherein:
the elevations are arranged in a helical elevation pattern on the braided tubular wall.

43. (Previously Presented) A body insertable stent, including:
a flexible self-expanding braided tubular wall comprising at least one first wire helically wound at a substantially constant first pitch and at least one second wire helically wound at a substantially constant second pitch different from the first pitch whereby the first and second wires cooperate to form multiple crossing points of the at least one first wire and the at least one

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 12

second wire;

wherein at a number of selected crossing points, said number being substantially less than the total number of crossing points, each of the first wire and the second wire is shaped to form respective first and second elevations extended in the same direction radially away from the braided tubular wall; and

wherein said elevations are arranged in at least one elevation pattern on the braided tubular wall.

44. (Previously Presented) The stent of claim 43 wherein:

said elevations extend radially outwardly from the braided tubular wall.

45. (Previously Presented) The stent of claim 43 wherein:

the at least one elevation pattern has a third pitch different from the first pitch and different from the second pitch.

46. (Previously Presented) The stent of claim 43 wherein:

the elevations have heights in the radial direction from the braided tubular wall of approximately one to two times the diameter of the helically wound wire.

47-65. (Cancelled)

66. (Previously Presented) A body insertable prosthesis, including:

a flexible self-expanding tubular mesh wall comprising a plurality of elongate wire segments cooperating to form multiple crossing points at which different ones of the elongate wire segments cross each other;

wherein at a number of selected crossing points, said number being less than the total number of crossing points, pairs of the elongate wire segments crossing one another are shaped to form respective first and second elevations extended in the same direction radially away from the tubular mesh wall; and

wherein the elevations are arranged in a helical elevation pattern on the tubular mesh wall.

67. (Previously Presented) The prosthesis of claim 66 wherein:

said elevations extend radially outwardly from the braided tubular wall.

68. (Previously Presented) The prosthesis of claim 66 wherein:

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 13

the plurality of elongate wire segments include a first wire segment wound helically at a first pitch and a second wire segment wound helically at a second pitch different from the first pitch, and the at least one elevation pattern has a third pitch different from the first pitch and different from the second pitch.

69-75. (Cancelled)

76. (Previously Presented) The prosthesis of claim 66 wherein:
the tubular mesh wall comprises at least one wire wound to form said crossing points, and said elongate wire segments comprise different length-portions of the at least one wire.

Application No: 10/674729
Filed: September 30, 2003

Brief on Appeal
Page 14

- (ix) Evidence Appendix - N/A
- (x) Related Proceedings Appendix - N/A

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